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10/071,537

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07/17/2007

EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/071,537

Applicant(s)

WILSON ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 1-5, 7-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211).**

Regarding claims 1, 2, 4, 9, and 10, Deaton teaches delivering shopping incentives individually customized to influence each customer (Column 4, Lines 50-54) in which the incentives are generated by a plurality of independently competing manufacturer controlled dynamic offer engines (Column 4, Lines 1-6, Figure 1, Reference 16, and Column 10, Lines 43-47) that customize each incentive to meet manufacturer objectives including market share (Column 4, Lines 45-49, Column 2, Lines 41-47, and Column 9, Lines 24-30). Deaton determines the incentives based on current purchases (scanned at a point of sale) (Column 9, Lines 37-38) and customer past purchase history (Column 4, Lines 50-54). Deaton does not appear to specify a wireless scanning device. Sloane teaches a wireless device with a UPC bar code scanner used by the shopper to scan product bar codes in a store (Abstract). The device uses the bar codes scanned, along with consumer purchase history (shopper

information) to determine an incentive for the user (Abstract). The incentive offered to the user could be a promotion for the product scanned or a promotion for other competitive products (this is an example of competitive incentive offer engines) (Column 3, Lines 16-28). The user is able to select which promotional offers to be redeemed (Column 3, Lines 16-28). The wireless device can communicate the redeemed incentives to a point of sale (Column 3, Lines 48-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to give the consumer a portable device for discount offers instead of supplying the offers at the point of sale when the customer is already checking out.

Regarding claims 3, 5, 7, 11-13, 15, and 16, Deaton teaches Internet connection, wireless connections, and dedicated lines (Column 9, Lines 15-23). Sloane teaches communication over radio frequency and cellular communications (Column 7, Lines 49-57).

Regarding claim 8, the circuitry contained within the device of Sloane is the same type of circuitry that could be found in a GPS, and therefore, Sloane's wireless device comprises GPS circuitry.

2. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Anttila (U.S Patent No. 6,862,575).

Regarding claims 6 and 14, neither Deaton nor Sloane teaches the wireless device as generating a bar code to be scanned by a point of sale. Anttila teaches a

wireless device that generates a scannable bar code (Column 5, Lines 6-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow Sloane's device to generate bar codes to promote ease of use.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to wireless bar code incentive devices:

U.S. Patent No. 6,327,570 to Stevens

U.S. Patent No. 6,434,530 to Sloane

U.S. Patent No. 6,314,406 to O'Hagan

U.S. Patent No. 5,250,789 to Johnsen

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JEFFREY D. CARLSON
PRIMARY EXAMINER